REMARKS

Claims 53-70 are pending in the application with claims 1-52 canceled herein or previously canceled. Claims 53-70 set forth limitations not previously considered by the Office. The subject matter of claims 53-70 is expressly supported by page 9, line 14 to page 10, line 17, page 4, line 12 to page 7, line 16, and elsewhere throughout the present specification. Each of the numeric limitations and/or ranges set forth in claims 53-70 are supported by the present specification.

Further, Applicants assert that the 35 USC 112, first paragraph, rejection on page 3 of the Office Action is improper with respect to now canceled claims 38 and 43. First, the limitation of 700 Torr is listed on page 10, line 14 of the present specification. Second, the Office's statement "that 500 °C is a specific number and does not contain a range (500-700 °C)" is clearly erroneous under the Patent Law.

Pursuant to MPEP 2163.05(III) and the decision of In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), the range of "25%-60%" was described in the original specification along with a specific example of "36%." Accordingly, the court found that a limitation to "between 35% and 60%" was supported by the specification and met the description requirement. The present specification describes the range of from about 10 Torr to about 700 Torr and gives a specific example of about 400 Torr. Thus, the specification supports the now claimed range of from about 400 Torr to about 700 Torr. For a variety of other limitations set forth in the claims, the present specification sets forth a broad range along with a specific example. However, in every claim that sets forth a lesser range included within the broad range, the lesser range is supported in the specification pursuant to MPEP 2163.05(III) and the decision of In re Wertheim.

All of the previously rejected claims are cancelled herein and new claims are added setting forth limitations not previously considered as now claimed in a combination of limitations. Applicants assert that the previous rejections are now moot. If the Office is of the opinion that all of the individual limitations in a given new claim were previously considered separately, then the Office should appreciate the need to reevaluate the cited references in light of the now claimed combination. Simply looking in such references or others for the changed or added limitations is not sufficient. Such reevaluation is required because the prior art must suggest to those of ordinary skill in the art, "that they should make the claimed composition or device, or carry out the claimed process." In re Vaeck, 947 F.2d 488, 20 USPQ 2d 1438, 1442 (Fed. Cir. 1991) (emphasis added).

Further, the text of 35 U.S.C. 103(a) requires that "the subject matter as a whole" must be obvious rather than select limitations. It is immaterial to an issue of obviousness if all the elements of a claimed combination are old in another context. What must be found obvious to defeat allowability of a patent claim is the underlying claimed combination. See, Kimberly-Clark Corp. v. Johnson & Johnson, 745 F.2d 1437, 1448, 223 USPQ 603, 609-10 (Fed. Cir. 1984.) Applicants assert that the new claims transform the subject matter of the previous claims such that if a suggestion or motivation to modify or to combine references previously existed, then it does not now.

The mere fact that the prior art can be modified does not make the modification obvious "unless the prior art suggested the desirability of the modification." In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). "When prima facie obviousness is established and evidence is submitted in rebuttal, the decision-maker must start over . . .. An earlier decision should not . . . be considered as set in concrete, and applicant's rebuttal

evidence then be evaluated only on its knockdown ability." In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (C.C.P.A. 1976) (emphasis added). At least for such reasons, all of the pending claims 53-70 are patentable and Applicants request allowance of such claims in the next Office Action.

Respectfully submitted,

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